

**REMARKS**

Applicant appreciates the amount of time the Examiner has devoted to this application and the concern the Examiner has shown with respect to the difficulties provided by the reference which, as discussed below, seem to present a novel point of law. As will be seen below, Applicant has attempted to amend the claims consistent with the Examiner's understanding of the references (including the McKissick document which Applicant does not believe to be a valid reference). In this spirit Applicant is hopeful that the Examiner will enter the claim Amendments made herein and allow the case, or, if necessary, issue a new Final Office Action.

**IDS omitted**

The IDS that was referenced in the October 6, 2005 Response was inadvertently omitted. That IDS is submitted herewith.

**Improper use of reference**

Applicant repeats his objection to the use of the McKissick unpublished application as a reference. The McKissick application has been cited by the Examiner because it is incorporated by reference in a published application. The authority for using a published application as a reference effective as of its filing date (and not its publication date) stems from 35 U.S.C. § 102(e) as properly cited by the Examiner. However, that provision of 35 U.S.C. § 102 (e), came into effect as part of a 1999 Amendment. However, the effective date of the 1999 Amendment was **one year after November 29, 1999** and was applicable **only to applications filed on or after** the effective date. Since the instant application has an effective filing date of July 27, 2000, it is not subject to the Amendment of 1999, and thus, the Examiner's rejection is without foundation and should be removed.

Because the pertinent provision of 35 U.S.C. § 102(e) is not applicable, this should dispose of the reference and the claims should be held allowable. However, to preserve Applicant's position on appeal, should an appeal become necessary, Applicant offers the following argument.

Applicant is unaware of any case law or M.P.E.P. section that covers the fact pattern presented by the Examiner's use of the McKissick reference. Thus, this seems to be a situation of first impression. If the Examiner is aware of any precedent for applying the references as he has then the Examiner is invited to please include any such precedent in his response so Applicant can better understand the PTO's position on this issue.

The Examiner, in response to Applicant's previous arguments, cites M.P.E.P. § 2163.07(e). Applicant does not dispute that matter can be incorporated by reference in a pending patent application. Applicant also does not dispute that any such incorporation by reference is "as much a part of the application as filed as if the text was repeated in the application and should be treated as part of the text of the application as filed."

This quote from the M.P.E.P. is accurate but since the M.P.E.P. serves only as a guideline it is not a substitute for the Statute, the Rules or for case law. Thus, it is important to examine the M.P.E.P. statements closely and to interpret them narrowly. While M.P.E.P. § 2163.07(e) does not explicitly state that § 2163.07(e) is an instruction to the Examiner (and to the public) as to what to include in the application for the purpose of determining compliance with enablement and claim support and other § 112 issue, that is what § 2163.07(e) is limited to.

The Courts have been clear, and the M.P.E.P. has accurately reflected, that it is the **public availability** of a document that gives rise to its use as a reference. It is well established that private publications are **never** available as a reference. Certainly abandoned applications (since they are held in private) are not valid references. Thus, M.P.E.P. § 2128 sets forth the standard that is to be followed for printed publications.

A reference is proven to be a "printed publication" upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.

Thus, the key factor in allowing a reference to be used as prior art is the **availability of the reference** to the public.

This public availability concept, which stems from 35 U.S.C. § 102(a), is so central to a document being available as a reference that it even applies to publications that are on file in the US Patent Office. Thus, M.P.E.P. § 2136.01 recites:

When there is no common assignee or inventor, a US application must issue as a patent or be published as a SIR or as an application publication before it is available as prior art under 35 U.S.C. § 102(e).

The authority allowing the Examiner to use the Ellis reference comes from 35 U.S.C. § 102(e) and allows the filing date to be used, provided the application was first published. It is the **publishing** of the application that Congress focused on to modify the “public” requirement by allowing the filing date to be used. This is an exception to 35 U.S.C. § 102(a) which requires documents to be public. As an exception it must be given narrow applicability. The Examiner, by attempting to now say that the McKissick document, which was held **private** by the owner of the document (because it was never published) was, in fact publicly available as early as the filings date of an application that happened to incorporate it by reference is violating the spirit, if not the scope, of 35 U.S.C. § 102(e) and goes against the mandates of 35 U.S.C. § 102(a) as well as against the PTO procedure as set out in M.P.E.P. §§ 2136.01 and 2128. Accordingly, the use of McKissick is not proper and the rejection based on McKissick should be removed.

In fact, the McKissic document still may not be available to the public because the only way it could be made available is if the McKissick document and the Ellis application have common assignees. The Examiner has not said that they do and thus the Examiner has not met his burden of showing that the McKissick document was even properly incorporated by reference. The Ellis document is silent on this fact. Thus, unless the Ellis and McKissick documents have common assignees the McKissick document is still not public since it is not a valid incorporation by reference since the document, at the time of the incorporation was not publicly available. Accordingly, the Examiner is respectfully requested to provide Applicant with copies of the assignment documents for both the Ellis and McKissick documents so that Applicant can make a proper determination as to the validity of the incorporation in the first instance.

### 35 U.S.C. § 102(e) Rejections

The Examiner has rejected claim 47 under 35 U.S.C. § 102(e) as being anticipated by Marsh et al (6,208,799). This rejection is traversed.

Applicant agrees with the Examiner that Marsh teaches the changing of start-stop times in accordance with schedule changes. In this regard, claims 49 and 58 have been cancelled. However, claim 47 specifically recites that it is the **end time** that is adjusted to accommodate changes in program length. Marsh discusses changes in program start and stop times, but nowhere does Marsh even hint at length changes being accommodated. Marsh is concerned with program delays and program cancellations. Interactive Program Guides (IPGs) are used for control purposes. Each IPG has a start time and a stop time associated therewith. These start and stop time pairs are continuously downloaded and compared to existing IPGs. When a mismatch occurs the new pair replaces the old pair. Such a system will not work when the start time has not been changed but the program runs overtime. Marsh does not discuss this situation and the operation of Marsh does not provide a structure for changing only the ending time of a program. Accordingly, claim 47 should be held allowable.

Claim 48 has been amended to recite that the change in program length occurs **after the start time** of the program. This would occur, for example, if a football game goes into overtime. See for example, Applicant's specification at paragraphs 0061 and 0062. Marsh does not in any manner discuss or even hint as such recorder adjustments during the actual recording time of a program. Accordingly, claim 48, as amended, should be held allowable.

Claim 50 has been amended to incorporate therein claim 52. With respect to claim 52 (now part of claim 50) the Examiner has said that the McKissick reference discusses recording taking place at the appropriate time. In the context of McKissick, the appropriate time refers to the time the program is scheduled by the transmission source for downloading to any number of users without regard to their physical location. In the claim, the transmission time is adjusted to the time zone of each user. Thus, the time of transmission

depends upon the user's time zone and not upon the scheduled download to all users. Nothing in McKissick even hints at adjusting the transmission time for any purpose and certainly not based on the user's time zone. Accordingly, claim 50, as amended, should be held allowable.

Claims 53-56 have been cancelled in keeping with the Examiner's restriction requirement.

Claims 1-15, 21-31, 50-52 and 59 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis (2004/0117831 A1) because Ellis incorporates by reference the McKissick application 09/378,533. As discussed in detail above, Applicant believes for several reasons that the McKissick application is not a proper reference. However, since the Examiner has not accepted Applicant's previous arguments on this point Applicant has no choice now but to point out where the rejected claims differ from McKissick.

Claim 4 (originally presented) is directed to the situation where, when a program is not available (non-match) the user request is made available to at least one content provider. The Examiner cites McKissick page 18, lines 30-33 and also page 24 , line 8 to page 25, line 12. In all of the cited portion of McKissick, in deed throughout McKissick, at all times the information that the user provides is matched against information provided to the transmission source. Even in the case of pay-for-view movies, someone (the movie provider) selects which movie or movies are to become available and if after such selection is made, a match exists with a user's recorded desires the selected movie is provided to the user. McKissick does not in any manner suggest that the user's recorded information is made available to the movie provider. It is the other way around, i.e. the movie (program) supplier's information is made available to the user. Nothing in what the Examiner has pointed out contradicts this operation. Accordingly, the Examiner seemingly has misunderstood the teaching of McKissick when he says that the user's information is provided to the third party. Accordingly, claim 4 should be held allowable.

Claim 6 specifically recites that the content provider and the user interact to deliver content to the user in accordance with the user's descriptive material. The Examiner has stated that the user activity is the ordering of the program. The provider's activity is the

program that matches the user's request. This is not "interacting between the content provider and said user" as specifically claimed. McKissick is a passive system where programs are passively matched against pre-stored requests. Interacting is an active participation. If the Examiner would like to see a wording change to clarify this aspect Applicant is willing to comply with the Examiner who is invited to please call Applicant at the below listed number to facilitate allowance of this application.

Claims 60–67 have been added in an attempt to move this application to issue. Claim 60, which is discussed in the specification at, for example, Paragraphs 0058, 0059 and 0060, allows a transmission source to only schedule for delivery a program to a user who has requested that program and not to all user's of the system. The McKissick document does not address this concept in any manner. Specifically, McKissick keeps track of user requests and if a program is scheduled for delivery over the network that matches a stored request then the scheduled transmission time is set in the user's memory in the user's set top box. But in no case does McKissick transmit or make available programs **only** to user's who have requested those programs. For example, McKissick specifically talks about the type of programs it will control. See, for example, McKissick page 15, line 29 through page 16, line 20. Clearly then, McKissick deals with scheduled programs, unscheduled programs that are coming soon, series that are announced but not scheduled, returning series, special events, etc. In every situation these programs are, or will be, sent out over one or more channels to anyone who has signed up for that channel. Nothing in McKissick indicates that the scheduling by the transmission source is dependant upon who or how many people have signed up as specifically recited in claim 60. Accordingly, claim 60 should be held allowable.

Claim 61 is directed to the situation where the transmission source makes the user requests known to other parties and the other parties decide when and if to provide the content. As discussed above, nothing in McKissick even hints at such an arrangement. In McKissick, the "other" parties decide on a schedule of programs and once this is decided then sets the recorders of those who have requested now scheduled programs. Nothing in McKissick even hints at a program being scheduled based on a user request. Accordingly, claim 61 should be held allowable.

Claim 66 is directed to a method in which user requests for specific information are stored, (as in McKissick); matching stored requests against programs that are scheduled (as in McKissick), upon a mismatch, making at least some of the recorded requests available to other providers and determining under control of the providers whether that provider has a program that matches a recorded request (McKissick does not teach this). In McKissick, the requests are stored and if some provider decides (independent from the stored requests) to provide a program then when the program becomes available it is matched against the pre-stored requests. Claim 66 goes on to recite that the scheduling of a specific program to be delivered to the user is because of the determined availability of that program. McKissick, as stated above, does not in any manner teach such a concept. In McKissick, in all situations, the provided programs are for all subscribers to the service and the scheduling of the programs is independent from what any user asked to see. It is only when the provider decides that the match condition can be met.

Claim 67 is directed to the situation where the determination of the scheduled program is accomplished by negotiation between the potential provider and the user. McKissick does not in any manner address this concept.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Any fee due with this response is reflected in the attached fee transmittal sheet. However, if an additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 05708/P005D1/08008819 from which the undersigned is authorized to draw.

Dated: December 7, 2005

Respectfully submitted,

By \_\_\_\_\_

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